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27683	7590	08/08/2006	EXAMINER GLASS, RUSSELL S	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			ART UNIT	PAPER NUMBER

3626
DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/977,777	Applicant(s) MERKIN ET AL.	
	Examiner Russell S. Glass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 26-28,30 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/15/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bakoglu et al., (5,983,369), in view of Johnson, (U.S. 6,904,592).

2. As per claim 1, Bakoglu discloses a method of upgrading the warranty of a computer system including a plurality of components in a configuration, the method comprising:

- (a) detecting, by the computer system, of a change in the configuration of the computer system, (Bakoglu, Figs. 2, 3, 7, 8, 9; col. 5, line 7-col. 6, line 5; col. 7, line 19-col. 8, line 16; col. 9, lines 5-55; col. 13, lines 13-57)(reading hardware and software configuration properties using interrogation software, software agents and factory-based identifiers is considered to be equivalent to detecting since it performs an identical function in substantially the same way and produces substantially the same results);
- (b) sending, by the computer system, of a warranty upgrade request to a remote warranty processor when a change in the configuration of the computer system is

Art Unit: 3626

detected, the warranty upgrade request including configuration information for the computer system. (Bakoglu, Fig. 2, 3, 7, 8, 9; col. 5, line 7-col. 6, line 5; col. 7, line 19-col. 8, line 16; col. 9, lines 5-55; col. 13, lines 13-57).

Bakoglu fails to expressly disclose sending a warranty upgrade request when a change in the configuration of the computer system is detected. However, this limitation would be obvious to one of ordinary skill in the art in view of Bakoglu. Bakoglu discloses a method that provides product registration, and uses software agents to analyze the configuration of hardware and software components, in order to validate and service warranties. Additionally, the software agent operates from the warranted computer system.

Bakoglu also fails to disclose a method of paying a warranty upgrade fee to prompt release of further warranty information. However, such a method is well-known in the art as evidenced by Johnson, (Johnson, Abstract, Fig. 6; col. 2, lines 26-48; col. 3, lines 14-29; col. 9, line 50-65).

It would be obvious to one of ordinary skill in the art at the time of the invention to configure the interrogation software to invalidate a registered warranty when an unwarranted change in the configuration of the computer system is detected, thus requiring warranty upgrade prior to use. The motivation would be to track and service computer system warranties online, (Bakoglu, Abstract).

It would have been obvious to one of ordinary skill in the art to combine Bakoglu and Johnson. The motivation would have been to update software at remote locations, create a record and provide an accounting, (Johnson, Abstract).

Art Unit: 3626

3. Claims 2, 4, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bakoglu in view of Osborn et al., (U.S. 6,182,048), and further in view of Johnson, (U.S. 6,904,592).

4. As per claim 2, Osborn discloses a method comprising receiving a warranty upgrade price dependent on the configuration information in the warranty upgrade request, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 65; col. 4, line 28-col. 5, line 40).

Osborn fails to disclose receiving a warranty upgrade price for a computer system including configuration information for the computer system. However, it would be obvious to one of ordinary skill in the art to apply the vehicle warranty upgrade and pricing method of Osborn to a computer system. Additionally, receiving configuration information for the computer system of a user, such information to be used for a variety of services, including warranties, is well known in the art as evidenced by Bakoglu, (Bakoglu, Abstract; col. 2, line 42-col. 3, line 14; col. 5, lines 60-65; col. 9, lines 5-55; col. 13, lines 13-57).

It would be obvious to one of ordinary skill in the art to combine Osborn and Bakoglu to create a method of upgrading the warranty of a computer system. The motivation would be to track and service computer system warranties online, (Bakoglu, Abstract).

It would have been obvious to one of ordinary skill in the art to add Johnson to the collective system. The motivation would have been to update software at remote

Art Unit: 3626

locations, create a record and provide an accounting, (Johnson, Abstract).

5. As per claim 4, Bakoglu fails to disclose a method further comprising receiving, by the computer system, a warranty authorization including a warranted configuration describing the configuration to be warranted. However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col. 4, line 28-col. 5, line 40).

The obviousness and motivation to combine Osborn and Bakoglu, and to further add Johnson, is as provided in the rejection of claim 2 and incorporated herein by reference.

6. Claims 5, 6, 9, 10, 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Olarig et al., (U.S. 6,032,257), and further in view of Johnson, (U.S. 6,904,592).

7. As per claim 5, Bakoglu fails to disclose a method further comprising the computer system receiving the warranty authorization, the warranty authorization including a warranted configuration describing the configuration to be warranted. However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col. 4, line 28-col. 5, line 40). The collective system of Osborn and Bakoglu fails to disclose a method further comprising receiving a digitally

Art Unit: 3626

signed warranty authorization. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The obviousness and motivation to combine Osborn and Bakoglu is as provided in the rejection of claim 2 and incorporated herein by reference.

It would be obvious to one of ordinary skill in the art at the time of the invention to add Olarig to the collective system of Osborn and Bakoglu. The motivation would have been to prevent warranty fraud, (Olarig, col. 4, lines 57-61).

It would have been obvious to one of ordinary skill in the art to add Johnson to the collective system. The motivation would have been to update software at remote locations, create a record and provide an accounting, (Johnson, Abstract).

8. As per claim 8, the collective system of Osborn and Bakoglu fails to disclose a method wherein the warranty authorization includes a unique identification number of the computer system. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu and Olarig, and to add Johnson is as provided in the rejection of claim 5 and incorporated herein by reference.

9. As per claim 9, the collective system of Osborn and Bakoglu fails to disclose a method further comprising the computer system authenticating a digitally signed

Art Unit: 3626

warranty authorization. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu and Olarig, and to add Johnson is as provided in the rejection of claim 5 and incorporated herein by reference.

10. As per claim 10, the collective system of Osborn and Bakoglu fails to disclose a method further comprising comparing, by the computer system, a warranted configuration in a warranty authorization with the configuration of the computer system, and storing the warranty authorization in secure storage if the warranted configuration matches the configuration of the computer system. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu and Olarig, and to add Johnson is as provided in the rejection of claim 5 and incorporated herein by reference.

11. As per claim 11, the collective system of Osborn and Bakoglu fails to disclose a method wherein a secure processor in the computer system performs the comparing and storing step. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

Art Unit: 3626

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu and Olarig, and to add Johnson is as provided in the rejection of claim 5 and incorporated herein by reference.

12. Claims 6, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu and further in view of Wallis et al., (U.S. Pub. 2001/0051884), and further in view of Johnson, (U.S. 6,904,592).

13. As per claim 6, the collective system of Osborn and Bakoglu fails to disclose a method wherein the warranty authorization includes warranty type information. However, such a method is well-known in the art as evidenced by Wallis, (Wallis, ¶¶ 14-19, 35-39, 46, 49).

The obviousness and motivation to combine Osborn and Bakoglu is as provided in the rejection of claim 2 and incorporated herein by reference.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Wallis to the collective system of Osborn and Bakoglu. The motivation would have been to save consumers the inconvenience of having to personally enter the information required to administer the warranty, (Wallis, ¶ 6).

It would have been obvious to one of ordinary skill in the art to add Johnson to the collective system. The motivation would have been to update software at remote locations, create a record and provide an accounting, (Johnson, Abstract).

Art Unit: 3626

14. As per claim 7, the collective system of Osborn and Bakoglu fails to disclose a method wherein the warranty authorization includes warranty duration information.

However, such a method is well-known in the art as evidenced by Wallis, (Wallis, ¶¶ 14-19, 35-39, 46, 49).

The obviousness and motivation to combine Osborn, Bakoglu, and Wallis, and to add Johnson, is as provided in the rejection of claim 6 and incorporated herein by reference.

15. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bakoglu in view of Rajagopalan, (U.S. 6,934,686), and further in view of Johnson, (U.S. 6,904,592).

16. As per claim 3, Backoglu discloses a sending step when a change in configuration is detected, (Bakoglu, Abstract; col. 2, line 42-col. 3, line 14; col. 5, lines 60-65; col. 9, lines 5-55; col. 13, lines 13-57).

Backoglu fails to disclose a method of comprising asking, by the computer system, the computer user if a warranty upgrade is desired prior to the sending step when a change in configuration is detected. However, such a prompting method is well-known in the art as evidenced by Rajagopalan, (Rajagopalan, col. 3, lines 20-42; col. 4, lines 13-34; col. 6, lines 27-53). Rajagopalan discloses a method wherein warranties are recommended based upon information obtained by the system. Recommending a different warranty is the equivalent of asking if a warranty upgrade is desired since it

Art Unit: 3626

performs an identical function in substantially the same way and produces substantially the same results.

It would be obvious to one of ordinary skill in the art at the time of the invention to recommend a warranty as disclosed by Rajagopalan, using configuration information obtained as disclosed by Backoglu. The motivation to combine Backoglu and Rajagopalan would be to create a custom warranty package, (Rajagopalan, col. 1, lines 5-22).

It would have been obvious to one of ordinary skill in the art to add Johnson to the collective system. The motivation would have been to update software at remote locations, create a record and provide an accounting, (Johnson, Abstract).

17. Claims 12, 14, 16, 22-25, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan, and further in view of Johnson, (U.S. 6,904,592).

18. As per claim 12, Osborn discloses a method of upgrading the warranty including a plurality of components in a configuration, the method comprising:

- (a) receiving, by a warranty processor, of a warranty upgrade request from the computer system, the warranty upgrade request including configuration information, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 65; col. 4, line 28-col. 5, line 40); and
- (b) determining, by the warranty processor, of a warranty upgrade price dependent on the configuration information in the warranty upgrade request, (Osborn, Fig. 1, 2, 4;

Art Unit: 3626

col. 1, line 51-col. 3, line 65; col. 4, line 28-col. 5, line 40).

Osborn fails to disclose a warranty upgrade request for a computer system including configuration information for the computer system. However, it would be obvious to one of ordinary skill in the art to apply the vehicle warranty upgrade and pricing method of Osborn to a computer system. Additionally, receiving configuration information for the computer system of a user, such information to be used for a variety of services, including warranties, is well known in the art as evidenced by Bakoglu, (Bakoglu, Abstract; col. 2, line 42-col. 3, line 14; col. 5, lines 60-65; col. 9, lines 5-55; col. 13, lines 13-57).

The collective system of Osborne and Backoglu fails to disclose a method of comprising asking, by the computer system, the computer user if a warranty upgrade is desired prior to the sending step when a change in configuration is detected. However, such a prompting method is well-known in the art as evidenced by Rajagopalan. Rajagopalan discloses a method wherein different warranties are recommended based upon information obtained from the computer the system, (Rajagopalan, col. 3, lines 20-42; col. 4, lines 13-34; col. 6, lines 27-53). Recommending a different warranty is the equivalent of asking if a warranty upgrade is desired since it performs an identical function in substantially the same way and produces substantially the same results.

Bakoglu also fails to disclose a method of paying a warranty upgrade fee to prompt release of further warranty information. However, such a method is well-known in the art as evidenced by Johnson, (Johnson, Abstract, Fig. 6; col. 2, lines 26-48; col. 3, lines 14-29; col. 9, line 50-65).

The obviousness and motivation to combine Osborn and Bakoglu is as provided in the rejection of claim 2 and incorporated herein by reference.

It would be obvious to one of ordinary skill in the art at the time of the invention to add Rajagopalan to the collective system of Osborn and Backoglu. The motivation to would be to create a custom warranty package, (Rajagopalan, col. 1, lines 5-22).

It would have been obvious to one of ordinary skill in the art to add Johnson to the collective system. The motivation would have been to update software at remote locations, create a record and provide an accounting, (Johnson, Abstract).

19. As per claim 14, Bakoglu and Rajagopalan fail to disclose a method further comprising transmitting, by the warranty processor, the warranty upgrade price to the computer system. However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col. 4, line 28-col. 5, line 40).

The obviousness and motivation to combine Osborn, Bakoglu, and Rajagopalan, and to add Johnson, is as provided in the rejection of claim 12 and incorporated herein by reference.

20. As per claim 16, Bakoglu and Rajagopalan fails to disclose a method further comprising generating, by the warranty processor, a warranty authorization including a warranted configuration. However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col. 4, line 28-col. 5, line 40).

The obviousness and motivation to combine Osborn, Bakoglu, and Rajagopalan, and to add Johnson, is as provided in the rejection of claim 12 and incorporated herein by reference.

21. As per claim 22, the collective system of Bakoglu and Rajagopalan fails to disclose a method wherein the warranty upgrade price is determined using the replacement cost of a component in the configuration as a factor. However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col. 4, line 28-col. 5, line 40; col. 5, line 62-64).

The obviousness and motivation to combine Osborn, Bakoglu, and Rajagopalan, and to add Johnson, is as provided in the rejection of claim 12 and incorporated herein by reference.

22. As per claim 23, the collective system of Bakoglu and Rajagopalan fails to disclose a method wherein the warranty upgrade price is determined using a remaining amount of warranty time for a component in the configuration as a factor. However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col. 4, line 28-col. 5, line 40, col. 7, lines 32-40)(warranty time measured in days or miles).

The obviousness and motivation to combine Osborn, Bakoglu, and Rajagopalan, and to add Johnson, is as provided in the rejection of claim 12 and incorporated herein by reference.

23. As per claim 24, the collective system of Bakoglu and Rajagopalan fails to disclose a method wherein the warranty upgrade price is determined using age of a component in the configuration as a factor. However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col. 4, line 28-col. 5, line 40)(make, model and year data constitutes age data for a covered component).

The obviousness and motivation to combine Osborn, Bakoglu, and Rajagopalan, and to add Johnson, is as provided in the rejection of claim 12 and incorporated herein by reference.

24. As per claim 25, the collective system of Bakoglu and Rajagopalan fails to disclose a method wherein the warranty upgrade price is determined using reliability data of a component in the configuration as a factor. However, such a method is well-known in the art as evidenced by Osborn, (Osborn, Fig. 1, 2, 4; col. 1, line 51-col. 3, line 67; col. 4, line 28-col. 5, line 40)(historical warranty policy data constitutes reliability data).

The obviousness and motivation to combine Osborn, Bakoglu, and Rajagopalan, and to add Johnson, is as provided in the rejection of claim 12 and incorporated herein by reference.

Art Unit: 3626

25. Claim 29 contains substantially the same limitations as claim 12 and therefore the reasoning provided in support of the rejection of claim 12 is incorporated herein by reference. A computer system is considered to be a configurable electrical device.

26. Claims 17, 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan, and further in view of Wallis, and further in view of Johnson, (U.S. 6,904,592).

27. As per claim 17, the collective system of Osborn, Bakoglu, and Rajagopalan fails to disclose a method wherein the warranty authorization includes warranty type information. However, such a method is well-known in the art as evidenced by Wallis, (Wallis, ¶¶ 14-19, 35-39, 46, 49).

The obviousness and motivation to combine Osborn, Bakoglu, and Rajagopalan is as provided in the rejection of claim 12 and incorporated herein by reference.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Wallis to the collective system of Osborn, Bakoglu, and Rajagopalan. The motivation would have been to save consumers the inconvenience of having to personally enter the information required to administer the warranty, (Wallis, ¶ 6).

It would have been obvious to one of ordinary skill in the art to add Johnson to the collective system. The motivation would have been to update software at remote locations, create a record and provide an accounting, (Johnson, Abstract).

Art Unit: 3626

28. As per claim 18, the collective system of Osborn, Bakoglu, and Rajagopalan fails to disclose a method wherein the warranty authorization includes warranty duration information. However, such a method is well-known in the art as evidenced by Wallis, (Wallis, ¶¶ 14-19, 35-39, 46, 49).

The statement of obviousness and motivation to combine Osborn, Bakoglu, Rajagopalan and Wallis, and to add Johnson, is as provided in the rejection of claim 17 and incorporated herein by reference.

29. Claim 13, 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan and further in view of Olarig, and further in view of Johnson, (U.S. 6,904,592).

30. As per claim 13, the collective system of Osborn and Bakoglu fails to disclose a method wherein the warranty upgrade request includes a unique identification number corresponding to the computer system. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu and Rajagopalan is as provided in the rejection of claim 12 and incorporated herein by reference.

It would be obvious to one of ordinary skill in the art at the time of the invention to add Olarig to the collective system of Osborn, Bakoglu and Rajagopalan. The motivation would have been to prevent warranty fraud, (Olarig, col. 4, lines 57-61).

It would have been obvious to one of ordinary skill in the art to add Johnson to the collective system. The motivation would have been to update software at remote locations, create a record and provide an accounting, (Johnson, Abstract).

31. As per claim 19, the collective system of Osborn and Bakoglu fails to disclose a method wherein the warranty authorization includes a unique identification number of the computer system. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu, Rajagopalan and Olarig, and to add Johnson, is as provided in the rejection of claim 13 and incorporated herein by reference.

32. As per claim 20, the collective system on Osborn, Bakoglu, and Rajagopalan fails to disclose a method further comprising digitally signing by the warranty processor, the warranty authorization to provide a digitally signed warranty authorization. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu, Rajagopalan and Olarig, and to add Johnson, is as provided in the rejection of claim 13 and incorporated herein by reference.

Art Unit: 3626

33. As per claim 21, the collective system on Osborn, Bakoglu, and Rajagopalan fails to disclose a method further comprising transmitting the digitally signed warranty authorization to the computer system. However, such a method is well-known in the art as evidenced by Olarig, (Olarig, Abstract, col. 2, line 56-col. 4, line 61).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu, Rajagopalan and Olarig, and to add Johnson, is as provided in the rejection of claim 13 and incorporated herein by reference.

34. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Osborn in view of Bakoglu, and further in view of Rajagopalan and further in view of Wallis, and further in view of Johnson, (U.S. 6,904,592).

35. As per claim 15, the collective system of Osborn and Bakoglu fails to disclose a method further comprising receiving payment, by the warranty processor, of the warranty upgrade price. However, such a method is well-known in the art as evidenced by Wallis, (Wallis, ¶¶ 14-19, 35-39, 46, 49; claims 6-8).

The statement of obviousness and motivation to create the collective system of Osborn, Bakoglu and Rajagopalan is as provided in the rejection of claim 12 and incorporated herein by reference.

It would have been obvious to one of ordinary skill in the art at the time of the invention to add Wallis to the collective system of Osborn, Bakoglu, and Rajagopalan.

Art Unit: 3626

The motivation would have been to save consumers the inconvenience of having to personally enter the information required to administer the warranty, (Wallis, ¶ 6).

It would have been obvious to one of ordinary skill in the art to add Johnson to the collective system. The motivation would have been to update software at remote locations, create a record and provide an accounting, (Johnson, Abstract).

Response to Arguments

Applicant's arguments filed April 5, 2006, have been fully considered but they are not persuasive because all limitations of the claim were addressed and evaluated in the earlier non-final rejection, including:

detecting, by the computer system, of a change in the configuration of the computer system, sending, by the computer system, a warranty upgrade request to a remote warranty processor when a change in the configuration of the computer system is detected, the warranty upgrade request including configuration information for the computer system.

"Paying a warranty upgrade fee to prompt release of further warranty information" was added by amendment and is addressed above in the new ground of rejection.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

Art Unit: 3626

not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivations to combine the cited prior art were found in the references and provided in the first office action.

Additionally, Applicant's arguments with respect to claims 1-25, 29 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is as follows: Rajagopalan, (U.S. 6,934,686); Yacoob, (U.S. 6,170,742); Baqai et al., (U.S. 5,410,726); Loveland, (U.S. 6,826,539); Binder; (U.S. 6,031,621); Li, (U.S. 6,609,050); Makhija et al., (U.S. 6,629,054); Perkowski, (U.S. 2004/0002966).

Art Unit: 3626

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3626

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RSG
6/22/2006

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JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER